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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HOLLIDAY, JAIME MICHELE

ART UNIT PAPER NUMBER

2686

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/507,314	Applicant(s) BOIERO ET AL.	
	Examiner Jaime M. Holliday	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/9/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement submitted on September 9, 2004, has been considered by the Examiner and made record in the application file.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 6-8, and 10** are rejected under 35 U.S.C. 102(b) as being anticipated by **Shoji et al. (U.S. Patent # 6,134,448)**.

Consider **claim 1**, Shoji et al. clearly show and disclose a mobile terminal reading on the claimed “specialized mobile terminal” suitable for being used in a mobile communication system reading on the claimed “mobile telecommunications network” (column 2, lines 64-65) comprising:

a receiving amplifier **21** and a transmitting amplifier **29** (figure 2), the two components reading on the claimed “RF circuit”; the receiving amplifier amplifies radio waves from base stations and the transmitting amplifier amplifies the high-frequency signal, once the radio waves, then the signal is transmitted from the antenna **20** to the base stations located inside the general calling area, reading on the claimed “pre-determined functions and exchanging data with said network” (column 5, lines 65-67, column 6, lines 7-8 and 28-32);

a controlling section **25** reading on the claimed “control circuit” which stores into a storage section base station identification information and the information of the intensity of received electric field as an information pair and outputs one or a plurality of information pairs reading on the claimed “associated to the RF circuit and able of controlling the functions of the RF circuit and of exchanging data measured by said RF circuit with said network through said RF circuit” (figure 2, column 6, lines 9-15 and 18-20);
characterized in that

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the controlling section reading on the claimed "control circuit" comprises control commands able

of permitting the position managing station (figure 5), which transmits a signal to and receives a signal from the mobile terminal via the base stations, comprises a mobile terminal calling section **51** for originating a call to the wireless mobile terminal reading on the claimed "network to recognize and call the specialized terminal" (column 3, lines 4-6, column 4, lines 54-56); and

with this arrangement, the mobile terminal detects the base station identification information and the information of the intensity of electric field of the received radio wave from the base station, and then transmits the same to the position managing section at the time when receiving the position managing station calls reading on the claimed "automatically transmitting to said network on reply to said call the data measured in order to determine the position of the specialized terminal" (column 4, lines 56-62).

Consider **claim 6**, and **as applied to claim 1 above**, Shoji et al. clearly show and disclose a mobile terminal reading on the claimed "specialized mobile terminal" characterized in that:

the wireless mobile terminal comprises an ID detection section **23** for detecting base station identification information transmitted from each of the base stations reading on the claimed "measuring of cell identifiers", and an intensity of electric field measuring section **24** for measuring an intensity of electric field of received radio waves from each of the base stations reading on the claimed "measuring of electromagnetic field" (column 4, lines 12-18); and in that

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it also comprises a transmission signal generation section for converting one or a plurality of information pairs reading on the claimed "electromagnetic field measurements and cell identifiers" into a transmission signal to the base station reading on the claimed "transmission of messages or signals containing said electromagnetic field measurements and cell identifiers" (figure 2 and column 4, lines 19-24).

Consider **claim 7**, and **as applied to claim 1 above**, Shoji et al. clearly show and disclose a mobile terminal reading on the claimed "specialized mobile terminal" characterized in that the controlling section, reading on the claimed "control circuit", comprises at least:

the controlling section storing in the storage section information pairs reading on the claimed "programmable logic; and/or an identification card, which can be programmed and associated to said specialized terminal" (figure 2 and column 6, lines 8-14)

Consider **claim 8**, Shoji et al. clearly show and disclose a positional information detecting system capable of specifying the position of a mobile terminal with a higher accuracy in a mobile communication system reading on the claimed "system for determining the position of mobile terminals comprising a mobile telecommunication network " (figure 1 and column 2, lines 61-65) comprising

a positioning managing station which comprises a position calculation section for determining the position of the mobile station reading on the claimed "having devices able to locate terminals" (column 3, line 4, lines 26-27); and

mobile terminal receives base station identification information that is periodically transmitted from the base stations, and then the signal from the mobile terminal received by base stations is transmitted from an antenna to a position managing station from the control station via the communication line reading on the claimed "terminals able of exchanging data measured by the terminals with said network" (column 5, lines 60-63, column 6, lines 30-35); characterized in that

position managing station (figure 5), which transmits a signal to and receives a signal from the mobile terminal via the base stations, comprises a mobile terminal calling section **51** for originating a call to the wireless mobile terminal reading on the claimed "network comprises devices able to recognize and call a mobile specialized terminal and determine the position of the specialized terminal" (column 3, lines 4-6, column 4, lines 54-56); and in that

this arrangement, the mobile terminal detects the base station identification information and the information of the intensity of electric field of the received radio wave from the base station, and then transmit the same to the position managing section at the time when receiving the position managing station calls reading on the claimed "specialized terminal is able of automatically transmitting to said network in reply to said call the data measured in order to permit said network to determine the position of the specialized terminal" (column 4, lines 56-62).

Consider **claim 10**, Shoji et al. clearly show and disclose a method for specifying the position of a mobile terminal with a higher accuracy in a mobile

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communication system reading on the claimed "method for determine the position of a specialized terminal connected to a mobile telecommunication network" (column 2, lines 62-65),
characterized by the following steps

position managing station demands the information pair of the base station from the mobile terminal in order to obtain the current position of the mobile terminal reading on the claimed "requesting by a user terminal the position of the specialized terminal" (column 8, lines 9-11);

the position managing station is provided with a mobile terminal calling section for originating a call to the mobile terminal reading on the claimed "validating through said network the user request, recognizing and calling on the basis of said request the specialized terminal" (figure 1 and column 3, lines 33-35); and

the position managing station comprising a position calculation section for determining the position of the mobile terminal based on the information pairs reading on the claimed "determining the position of the specialized terminal on the basis of data measured and sent by said terminal to said network in reply to said call" (column 3, lines 26-27).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 2, 3 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shoji et al. (U.S. Patent # 6,134,448)** in view of **Singer et al. (U.S. Patent # 5,485,163)**.

Consider **claim 2**, Shoji et al. clearly show and disclose the claimed invention as **applied to claim 1 above**.

Shoji et al., however, does not specifically disclose that the command controls of the mobile terminal reading on the claimed "specialized terminal" can be activated under direct control of a user terminal connected to the mobile communication system reading on the claimed "mobile telecommunications network."

In the same field of endeavor, Singer et al. clearly show and disclose a system and method of a portable locator device 4 (PLU) reading on the claimed "specialized mobile terminal" in a communications network, reading on the claimed "mobile telecommunications network." The PLU is activated either by an external signal generated at a remote activation source, such as a subscriber reading on the claimed "control circuit can be activated by means of signals transmitted by said network to said mobile terminal under direct control of a user terminal connected to the network" (figure 1 and column 1, line 64 – column 2, line 2).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow a subscriber reading on the claimed "user terminal" to activate the control commands of the PLU reading on the claimed "specialized mobile terminal" as taught by Singer et al. in the positional information detecting system of Shoji et al. in order to specify the position of the mobile terminal reading on the claimed "specialized mobile terminal" with a higher accuracy (Shoji et al., column 2, lines 62-64).

Consider **claim 3**, Shoji et al. clearly show and disclose the claimed invention as **applied to claim 2 above**.

Shoji et al., however, does not specifically disclose a user terminal to activate the mobile terminal reading on the claimed "specialized mobile terminal" and that a device identification number is associated to the user terminal.

In the same field of endeavor, Singer et al. clearly show and disclose that the subscriber may be operating a mobile unit 6 reading on the claimed "user terminal" which may be a cellular telephone. If the mobile unit, reading on the claimed "user terminal," is a cellular phone, then there will be a phone number associated with it reading on the claimed "device identification number associated to the user terminal" (column 4, lines 36-40). Once activated, the PLU, reading on the claimed "specialized mobile terminal," transmits a location signal, which is received by one or more network service nodes which then forward the information along with identifying node information to a network location processor, and the determined location is forwarded to the requesting subscriber, reading on the claimed "user terminal enabled to request and automatically receive the determined position of the specialized terminal" (column 2, lines 2-9).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a mobile unit, such as a cellular phone, reading on the claimed "user terminal," since it would be associated with a phone number, reading on the claimed "device identification number," as taught by Singer et al. in the system and method of Shoji et al. in order to successfully request and receive location information from the mobile terminal, reading on the claimed "specialized mobile terminal."

Consider **claim 9**, Shoji et al. clearly show and disclose the claimed invention as **applied to claim 8 above**.

Shoji et al., however, does not specifically disclose a system that comprises a user terminal which activates the mobile terminal reading on the claimed "specialized mobile terminal" and that a device identification number is associated to the user terminal.

In the same field of endeavor, Singer et al. clearly show and disclose a system which comprises a subscriber that may be operating a mobile unit, reading on the claimed "user terminal," which may be a cellular telephone. If the mobile unit, reading on the claimed "user terminal," is a cellular phone, then there may be a phone number associated with it, reading on the claimed "device identification number associated to the user terminal" (column 4, lines 36-40). Once activated, the PLU, reading on the claimed "specialized mobile terminal," transmits a location signal, which is received by one or more network service nodes which then forward the information along with identifying node information to a network location processor, and the determined location is forwarded to the requesting subscriber, reading on the claimed "user terminal enabled to request and automatically receive the determined position of the specialized terminal" (column 2, lines 2-9).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a mobile unit, such as a cellular phone, reading on the claimed "user terminal," since it would be associated with a phone number, reading on the claimed "device identification number," as taught

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by Singer et al. in the system of Shoji et al. in order to successfully request and receive location information from the mobile terminal, reading on the claimed "specialized mobile terminal."

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Shoji et al. (U.S. Patent # 6,134,448)** in view of **Hoff (WO Patent # 96/26614)**.

Consider **claim 4**, Shoji et al. clearly show and disclose the claimed invention as **applied to claim 1 above**.

Shoji et al., however, does not specifically disclose that the mobile terminal, reading on the claimed "specialized mobile terminal," has an activation element.

In the same field of endeavor, Hoff clearly shows and discloses a device for locating an object within the service area of a cellular communications network, reading on the claimed "specialized mobile terminal suitable for being used in a mobile telecommunications network" (page 4, lines 5-8). The device, reading on the claimed "specialized mobile terminal," is characterized by an activating means for activating the transmitting means in response to an activation signal. The activation means may further include a "panic" switch **305** on the device and may be arranged to provide the activation signal in response to actuation of the switch reading on the claimed "activation element associated to the specialized mobile terminal and capable of activating said control commands" (page 4, lines 16-18, page 7, lines 27-30).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a "panic switch", reading on the

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claimed "activation element," on the device, reading on the claimed "specialized mobile terminal," as taught by Hoff, in the system and method of Shoji et al., in order to allow the position managing station to originate a call to the mobile terminal, reading on the claimed "permitting network to recognize and call the specialized terminal" (column 3, lines 33-35).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Shoji et al. (U.S. Patent # 6,134,448)** in view of **Hoff (WO Patent # 96/26614)**, as applied to **claim 4** above, and in further view of **Hoisko (EP 1,148,754 A2)**.

Consider **claim 5**, the combination of Shoji et al. and Hoff as discussed in **claim 4** above shows the limitations claimed, except they do not specifically disclose that the mobile terminal or device, reading on the claimed "specialized mobile terminal" has an displaying element that is capable of displaying its position.

In the same field of endeavor, Hoisko discloses a method of operating a mobile station, reading on the claimed "specialized mobile terminal," such as a cellular telephone or a wireless terminal, that includes a location determination function and a user message function (abstract and column 1, lines 5-8 and 14-17). In one embodiment of the invention, both mobile stations transmit their location information to the network operator, who in turn provides instructions in a return message to one or both mobile stations, reading on the claimed "specialized terminal characterized by a displaying element associated to the specialized terminal and capable of displaying the position of the specialized terminal identified by said network" (figure 1 and column 8, lines 5-14).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to embody the invention as a cellular telephone as taught by Hoisko, in the system and method of Shoji et al. and Hoff, in order to display the location information of the mobile terminal on its screen.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Filizola et al (U.S. Pub # 2004/0058691 A1)** discloses a system and method for identifying the position of cellular telephones, reading on the claimed "specialized mobile terminals." The location system includes a cellular telephone that comprises a radio frequency circuit and a control circuit 25 connected to the RF circuit 22 and capable of controlling the activities of the cellular telephone 12 on the basis of programs stored in the control circuit, reading on the claimed "specialized mobile terminal comprising: an RF circuit and a control circuit associated to the RF circuit and able of controlling the functions of the RF circuit."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime M. Holliday whose telephone number is (571) 272-8618. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SPE 2686